

REMARKS

The specification has been amended to remove reference to ATCC deposit information as well as remove embedded hyperlink text. Claim 1 and Claim 6 have been amended. No New matter has been added by virtue of the amendments. Claims 1-3, 6-and 25-42 are pending.

Objections to the Specification

The disclosure was objected to because it contains reference to ATCC deposit information as well as containing embedded hyperlinks in the text.

Applicants have amended the specification to remove reference to ATCC deposit information and additionally to remove hyperlinks. It is believed the amendments render the objections moot. Reconsideration and withdrawal of the Examiner's objections to the specification is thus requested.

The Rejection of Claims 1-3, 6 and 25-42 under 35 U.S.C. §101 Should Be Withdrawn

Claims 1-3, 6 and 25-42 were rejected under 35 U.S.C. 101 because "the claimed invention is not supported by either a substantial asserted utility or a well established utility." Applicants respectfully traverse the rejection.

Applicants appreciate the Examiner's acknowledgement regarding credible utilities set forth in the specification for the claimed nucleic acids, including detection of nucleic acids, screening assays to identify molecules that bind and regulate the polypeptide encoded by the nucleic acids, methods for producing the polypeptides encoded by the nucleic acids, as well as therapeutic methods using the nucleic acids. Applicants submit additionally disclosed utilities include diagnostic applications utilizing, for example, nucleic acids or antibodies which recognize proteins encoded by nucleic acids.

Applicants respectfully point out specific diseases for treatment and/or diagnosis using the claimed nucleic acids, proteins encoded by the nucleic acids, or using compounds identified using methods utilizing the claimed nucleic acids are in fact set forth in the specification. For example, at page 14, lines 15-18, Applicants identify specific uses for treatment of certain cancers. Still further, such disclosure is supported in the Exemplification at Example 3, page 99-100 where increased expression in certain tumor cells is identified as compared to normal cells of the same origin. Thus, in contrast to the Examiner's assertions, Applicants submit a utility specific for nucleic acids encoding 47324 has in fact been disclosed.

Furthermore, Applicants submit the utilities set forth for treatment and/or diagnosis using the claimed nucleic acids, proteins encoded by the nucleic acids, or using compounds identified using methods utilizing the claimed nucleic acids are also substantial utilities.

Finally, the Examiner asserts the utility analysis of the current situation tracks Example 12 of the utility guidelines, further demonstrating the situation as lacking a specific, substantial, “real world” use. Applicants, however, respectfully point out the CAVEAT section in the analysis at Example 12. (See Federal Register: December 21, 1999, revised Guidelines for Utility.) Applicants submit the present situation is in fact akin to the CAVEAT situation, where, the identified Receptor is disclosed as being identified on melanoma cells but not on normal skin cells. In the Guidelines, it is acknowledged the analysis changes and a utility rejection under 35 USC § 101 should not be made. The present specification provides a description whereby the claimed nucleic acids are differentially expressed in prostate tumor, colon tumor, lung tumor and fibrotic liver compared to normal samples. See specification, Example 3, pages 99-100. This disclosure is the basis, at least in part, for Applicants’ assertion for the utility of diagnostics and/or therapeutics utilizing the claimed compositions for at least certain cancers, e.g., prostate, colon, lung. Reconsideration and withdrawal of the rejection under 35 USC § 101 is thus respectfully requested.

Claims 1-3, 6 and 35-42 were also rejected under 35 USC 112, first paragraph due to lack of satisfying the utility requirement. For the reasons discussed above, Applicants submit the utility requirement has been met and respectfully request reconsideration and withdrawal of the rejection under 35 USC 112, first paragraph.

The Rejection of Claims 1, 3, 6 and 28, 33, 38 and 40 under 35 U.S.C. § 112, First Paragraph, Should Be Withdrawn

Claims 1, 3, 6, and 28, 33, 38 and 40 were rejected under 35 U.S.C. 112, first paragraph, for “failing to comply with the written description requirement”. Further, the Examiner has rejected the claims under 35 U.S.C. 112, first paragraph, for “failing to comply with the enablement requirement.

In an effort to further prosecution, Applicants submit the claims have been amended to remove reference to fragments and molecules comprising percent identity to SEQ ID NOs: 1, 2, and/or 3. It is believed the present amendment thus render the rejection moot. Reconsideration and withdrawal of the rejections under 35 USC 112, first paragraph is requested.

CONCLUSIONS

In view of the amendments and remarks herein, Applicants respectfully submit that the objections and rejections presented by the Examiner are now overcome and that this application is in condition for allowance. If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned.

It is believed that this paper is being filed timely and no extensions of time are required. In the event any extensions of time are necessary, the undersigned hereby authorizes the requisite fees to be charged to Deposit Account No. 501668.

Entry of the remarks made herein is respectfully requested.

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Respectfully submitted,

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